

REMARKS

Claims 1 - 20 remain active in this application. Claim 2 has been amended to make minor editorial revisions and improve syntax. No new matter has been introduced into the application. The continued indication of allowability of claim 6 is noted with appreciation.

Initially, the Examiner's attention is respectfully called to the paragraph bridging pages 9 and 10 of the previous response in which it was pointed out that at least claims 16 - 20 contain the same explicitly recited feature as allowed claim 6 but are indicated as included within grounds of rejection based on prior art in that action and the present action. No response to these remarks is seen and no basis for rejection under 35 U.S.C. §112 appears in either action from which some reason for according recitations of the claims less weight than is accorded to those recitations in claim 6 might be discerned. If the Examiner persists in the rejection of claims 16 - 20 it is respectfully requested that some response to these remarks be made in order to more fully convey the Examiner's position and expedite resolution of any issues which may exist.

Claims 1 - 5, 7, 9, 10, 12, 15, 18 and 20 have been rejected under 35 U.S.C. §103 as being unpatentable over Setlak et al. and claims 8, 11, 13, 14, 16, 17 and 19 have been rejected under 35 U.S.C. §103 as being unpatentable over Setlak et al. and Fujiwara et al. These grounds of rejection are respectfully traversed as being clearly erroneous and improper, as is plainly evident from the Examiner's comments in regard thereto.

In essence, the Examiner admits that Setlak et al. does not teach or suggest removal of static electricity through a plate adjacent a fingerprint reading portion.

(Plate 54 mentioned by the Examiner and the cited passages are directed to detection of placement of a finger and the provision of power to certain circuits which discharge of static electricity is performed through plate 53 and a bleed resistor of Figure 4 which the Examiner does not mention. In this regard, the bleed resistor slows the discharge of static electricity and thus, while Setlak et al. contains incidental mention of a cover for a fingerprint-reading portion at column 6, lines 43 - 47, (without mention of cooperation with a plate, located as claimed) such an arrangement does not guarantee full discharge of static electricity prior to placement of a finger on the fingerprint-reading portion.) The Examiner then proceeds to assert that there is no disclosed advantage, disclosed purpose or solution to any disclosed problem associated with a plate or a cover and asserts obviousness *based on the asserted recognition by those skilled in the art that the invention would operate equally well as the apparatus of Setlak et al.* At best, this analysis is inverted from that required by the policies and standards of the USPTO based on *Graham v John Deere* and ignores clear evidence of non-obviousness such as that discussed in M.P.E.P. §716.02(a) and, in any case, improper.

Further, the Examiner's assertion concerning lack of disclosure of advantages is substantively incorrect, as well. In fact, no less than four distinct advantages are disclosed for each of the disclosed preferred embodiments (e.g. discharge through a plate adjacent a cover, discharge through a plate and/or a cover and discharge through a latch or fitting on a cover) of the invention. These advantages are:

1. the cover protects the fingerprint-reading apparatus when not in use for reading a fingerprint (see, for example, page 8, line 25, page 10, line 27, to page 11, line 1,

page 12, line 28, page 15, lines 9 - 10, page 16, lines 24 - 25);

2. the static electricity is fully discharged prior to the user being able to place a finger on the fingerprint-reading apparatus (see, for example, page 9, lines 18 - 19, page 9, lines 24 - 25, page 11, lines 21 - 22, page 13, lines 22 - 23, page 14, lines 2 - 3, page 15, lines 6 - 9) which not only prevents damage but erroneous operation due to noise (which Setlak et al. addresses with a complex delay arrangement such that power is not applied until a period sufficient to "bleed" off static charge has elapsed after the finger is placed on the fingerprint-reading apparatus, as noted at column 6, lines 32 - 47, and which is avoided in the present invention with the consequent result of increasing response speed);

3. The action of opening a cover is a natural motion and the user is unaware of the static electricity discharge (see, for example, page 9, lines 21 - 22, page 13, lines 26 - 27, page 15, lines 3 - 4); and

4. the discharge of static electricity prior to placing a finger on the fingerprint-reading apparatus is unavoidable because of the cooperation of the cover (which may be of several disclosed forms) with the location of the plate and/or fingerprint-reading portion (see, for example, page 10, lines 10 - 11).

All of these meritorious and unexpected functions of the invention are supported by the admitted differences of the claimed subject matter from Setlak et al. or recited distinctions from Setlak et al. which the Examiner does not even mention in the discussion of the rejections.

Therefore, it is clearly seen that the Examiner's assertion that no advantages are disclosed is erroneous and, in any case, provides no basis for ignoring recited distinguishing features of the invention (e.g. providing a connection to ground in combination with a cover for the fingerprint-reading apparatus which the statement of the rejections does not mention) or deeming them to be obvious without supporting evidence thereof, particularly when Setlak et al. does not address the problems addressed by the invention, much less providing a solution thereto. Setlak et al. does not lead to any expectation of success in doing so and thus does not provide evidence of a level of ordinary skill in the art which would support a conclusion of obviousness in regard to any claim in the application, much less a *prima facie* demonstration of obviousness, of which the rationale stated by the Examiner fails far short. Under 35 U.S.C. §103, all recitations of the claim must be answered by some combination of direct teachings or suggestions of a combination of references and/or by evidence of the level of ordinary skill in the art at the time the invention was made. 35 U.S.C. §103 does not condone giving no patentable weight to any feature of the invention recited in the claims, particularly based on the inverted rationale stated by the Examiner that the invention would perform equally well as the apparatus of Setlak et al.

As previously pointed out, Fujiwara et al. does not supplement the teachings or suggestions of Setlak et al. at any of the points of deficiency of Setlak et al. to answer the recitations of the claims nor does the Examiner assert that it does. Fujiwara et al. is cited only for the teaching of use of a conductive resin layer but the passage of Fujiwara et al. (column 11, lines 20 - 26) relied upon by the Examiner contains no mention of conductivity while it is well-recognized that the refractive index of a material (for which the

layer is provided in Fujiwara et al. and which is relied upon by the Examiner for motivation for combination with Setlak et al.) can be used to evaluate the dielectric qualities of the material. Accordingly, it is respectfully submitted that the asserted grounds of rejection are clearly improper and erroneous and reconsideration and withdrawal of the same are respectfully requested.

Since all rejections, objections and requirements contained in the outstanding official action have been fully answered and shown to be in error and/or inapplicable to the present claims, it is respectfully submitted that reconsideration is now in order under the provisions of 37 C.F.R. §1.111(b) and such reconsideration is respectfully requested. Upon reconsideration, it is also respectfully submitted that this application is in condition for allowance and such action is therefore respectfully requested.

If an extension of time is required for this response to be considered as being timely filed, a conditional petition is hereby made for such extension of time. Please charge any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 50-2041.

Respectfully submitted,



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